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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,217	09/25/2001	Kaoru Indoh	214129US0XPC	8456

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EXAMINER
HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/926,217	Applicant(s) INDOH ET AL.
	Examiner Keith Hendricks	Art Unit 1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,5 and 7-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,5 and 7-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The previous rejection under 35 U.S.C. 112, first paragraph has been withdrawn in view of applicants' comments in the instant and previous response, as well as those discussed in the interview of May 27, 2003.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

i) Claims 1, 4-5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagata et al. (US PAT 5,665,407, of record). The reference and rejection are taken as cited in a previous Office action.

Applicants' arguments filed June 12, 2003, have been fully considered but they are not persuasive. Applicants state that the claim limitation of "1.35 to 1.50 times" water volume demonstrates "unobviously superior results", and "result-effectiveness."

This is not deemed persuasive for the reasons of record. Again, the previously-cited obviousness rejection (now withdrawn) was necessitated by applicants' improper amendment to the claims. However, the current rejection is made under 35 U.S.C. 102(b). Secondary considerations of obvious are not

germane to a rejection under 35 U.S.C. 102(b) where the reference anticipates and teaches the limitations of the claims. Again, these ranges and amounts of water content and salt content appear to fall within applicants' claims of 1.35-1.50 (1.35-1.65) times the weight of the raw material mixture. Furthermore, the reference is not limited to the teachings of one example, as applicants point to example 5 with regard to the amount of salt water utilized. Note that the instant claims do not require the presence of two of the three raw materials (soy and wheat at a possible 0%), thus affecting the percentage amount of water utilized therein, as well. It is noted that at the top of column 3, the reference states that the material is "charged with water or an aqueous solution of common salt in a conventional manner, subjected to a usual control of moromi production at 10° - 60° C for 3 days to 5 months for fermentation and maturing." Furthermore, each of the examples of the reference utilize a "23% aqueous solution of common salt", thus reading on the specific percentages instantly claimed. Finally, ratios regarding the amounts of raw materials and aqueous solution are provided at column 7.

ii) Claims 1, 4-5 and 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukushima et al. (US PAT 5,869,115). The reference and rejection are taken as cited in a previous Office action.

Applicants' arguments filed June 12, 2003, have been fully considered but they are not persuasive. Applicants state that "salt water is present in an amount of 1.76 times the weight of the raw material mixture", in example 1 of the reference.

This is not deemed persuasive for the reasons of record. Initially from the referenced example, it is unclear upon which amounts of water applicant is basing this conclusion. Furthermore, it is clear that the reference is not limited to a specific amount of water utilized in a single example, as broad ranges have been provided and utilized. Again, absent any clear and convincing evidence and/or arguments to the contrary, the ranges and amounts of water content and salt content appear to fall within applicants' claims of 1.35-1.50 times the weight of the raw material mixture.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata et al. (US PAT 5,665,407). The reference is taken as cited of record.

Regarding the percentage of salt water, applicants' independent claims recite a range of 7-24%, whereas the reference utilizes 23%. Applicants' specification demonstrates no difference between these two amounts. While the reference does not specifically demonstrate the properties of the product when 22% salt water is utilized, the claimed invention still does not provide for an *unexpected* result. Further, the slight alteration of salt content would have been expected to have a corresponding and parallel change in the resultant product, regarding such factors as total nitrogen (TN), JAS color, and Glu/TN content, which were addressed in the reference, for example, at Tables 1 and 2. Obviously, the proportion of the starting materials would naturally affect the resultant outcome, and in logical, linear fashion with regard to the percentages of the components used therein. The reference claim 1 broadly provides for "adding to the koji product an aqueous solution of common salt to form a salt-containing koji product", and applicants themselves have previously admitted on the record that "such limitations may be within the broad scope of Nagata et al." Thus, the use of an amount of salt, for example at 22%, would not have been expected to produce a *patentable* difference over that exemplified in the reference, to 23%. One of ordinary skill in the art would have recognized this factor, and it would have been obvious to have slightly modified the amounts of salt concentration in the water, especially in light of the fact that the water amounts and moisture contents were disclosed in broad ranges, as well.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

KEITH HENDRICKS
PRIMARY EXAMINER